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PRE-APPEAL BRIEF REQUEST FOR REVIEW


Applicant : Jae Keol Rhee, *et al.*
App. No : 10/596,412
Filed : June 13, 2006
For : NOVEL OXAZOLIDINONE
DERIVATIVES
Examiner : Patricia L. Morris
Art Unit : 1625
Conf. No. : 6355

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Carolyn A. Favorito, Reg. No. 39,183

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the rejections of Claims 51-52 as set forth in the Final Office Action in the above-identified application. No amendments are being filed with this request.

Enclosed with this Request is a Notice of Appeal.

REASONS FOR REQUEST

Review of the above-identified application is requested for the following reasons:

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. § 103

Claims 51-52 are rejected under 35 U.S.C. § 103 as being obvious over Lee (US 6,689,779), Chen (US 7,129,259), Fukuda I (US 2005/0038092), II (US 2007/0185132) and Barbachyn I (US 5,523,403), II (US 5,565,571). The Examiner did not establish *prima facie* obviousness, and thus the Examiner's rejection contains clear error. First, the Applicants

established without challenge that compounds made by the claimed methods are novel and nonobvious, and thus that the claimed methods for making them are novel and nonobvious. Second, the Applicants established without challenge that the cited references do not teach all of the claimed steps, for example, the cited references teach neither the claimed intermediates nor the novel and nonobvious compounds made from the claimed methods. Third, the Applicants established without challenge that the Examiner applied an incorrect standard for establishing obviousness, namely, a “reaction of a specific phenyl compound [which differs from a claimed intermediate] with a halogenating agent or tin reagent does not render the process step itself patentable” does not include a consideration of the claimed subject matter as a whole. The errors and underlying factual assertions are discussed below in more detail.

First, the Examiner’s rejection contains clear error because the cited references do not teach the non-obvious compounds recited as the products in method Claims 51-52, which are material limitations in accordance with a proper obviousness determination. *See* Amendment filed May 11, 2009. Therefore, the Examiner has not considered the subject matter of Claims 51-52 “as a whole,” which constitutes clear error. Specifically, the Applicants established on the record that the compounds made from the claimed methods are novel and nonobvious, and thus that the claimed methods for making them are novel and nonobvious. Amendment filed May 11, 2009 (page 17) and the Response filed August, 27, 2009 (pages 17-18). These assertions have neither been rebutted nor even challenged by the Examiner. The Examiner’s obviousness position is not tenable without rebutting or challenging these assertions.

Second, the Examiner’s rejection contains clear error because it relies on a combination of intermediates in the cited art that differ from Claim 51-52’s intermediates, to produce compounds that differ from Claim 51-52’s Formula (V) and Formula (I), that is insufficient to establish obviousness. *See* Response filed August 27, 2009, pages 17-18. The Applicants asserted that the intermediate materials and final compounds made according to the cited art differ from the intermediate materials and compounds of Claim 51’s Formula (V) or Claim 52’s Formula (I). *See* Response filed August 27, 2009, pages 17-18. The Applicants further asserted that the alcohol of formula (II) recited in Chen or the present claims as alleged by the Examiner is lacking in both Chen and the present claims. *See* Response filed August 27, 2009, page 18. The Examiner did not rebut or challenge these assertions. The Examiner’s rejection contains clear error because the Examiner did not establish that the cited references, alone or in

combination, disclose or suggest the elements recited in Claims 51-52. *See* Response filed August 27, 2009.

Third, the Examiner's rejection contains clear error because the Examiner did not apply the correct standard for determining obviousness. *See* Response filed August 27, 2009. The Examiner concluded that the "reaction of a specific phenyl compound with a halogenating agent or tin reagent does not render the process step itself patentable (emphasis added)." *See* Office Action dated August 11, 2009. As mentioned above, the Examiner's reference to the patentability of a particular step indicates that she did not consider the invention "as a whole," which is clear error.

As the Examiner has failed to examine the claimed invention as a whole, has not established that the cited references alone or in combination disclose or suggest all elements of the rejected claims, and has applied the incorrect standard for determining obviousness, this rejection contains clear error. The obviousness rejection is further deficient in light of the above unrebutted facts. As the communications between the Applicants and the PTO establish the factual record, the unrebutted and unchallenged assertions must be accepted as true factual findings (*see* M.P.E.P. § 707.07(f)). As the factual findings of record strongly support non-obviousness of the claims over the cited references, the Examiner's failure to address and rebut Applicants' evidence and arguments constitutes clear error.

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 52 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for use of the term "convert." The Examiner did not establish that the scope of the claims would be unclear to one of ordinary skill in the art, and thus the Examiner's rejection contains clear error. *See* Office Action dated August 11, 2009 (page 5) and the Response filed August 27, 2009 (pages 18-19). Applicants asserted that the chemical syntheses of Examples 1-58, for example, provide sufficient clarity of the scope of the claims to a skilled artisan. *See* Response filed August 27, 2009, pages 18-19. The Examiner did not rebut or challenge these assertions. As the communications between the Applicants and the PTO establish the factual record, the unrebutted and unchallenged assertions must be accepted as true factual findings (*see* M.P.E.P. § 707.07(f)). Although the Applicants attempted to amend Claim 52 to change "convert" to "react...form" to advance prosecution and to make the claims in better condition for appeal, the Examiner did not

enter these amendments. Nonetheless, these terms are interchangeable and thus the error in the rejection and the factual assertions apply to either term.

Petition

On the same date as the filing of this Pre-Appeal Brief Request for Review, the Applicants have filed a Petition requesting reconsideration of the Examiner's restriction of method Claims 53-73.¹ In the interest of maximizing efficiency and promoting compact prosecution, Applicants respectfully request the Pre-Appeal Brief Review Panel to communicate with the Office of Petitions such that all of the claims will be considered for allowance.

CONCLUSION

The rejections of the claims are clearly erroneous and must be reversed. Accordingly, the claims are in condition for allowance. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-14-09

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¹ Withdrawn independent Claim 53 recites the final method step as recited in examined Claim 52 and thus the Examiner has not established that the withdrawn method claims of this national phase application are materially different and therefore has not established lack unity of invention with Claims 51-52, which are currently under examination. Upon allowance of the method claims, the remainder of the claims directed to compounds, compositions, and methods of use should be rejoined in accordance with unity of invention practice.